

Compassion in Registration: A Lesson in Filing Narrow Trademark Applications

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Identical trademarks can coexist, as the Trademark Trial and Appeal Board once again emphasized when it overturned the refusal of a COMPASSION IN ACTION mark. The Board's decision is both a lesson in strategically narrowing an application's services and a cautionary tale of how to build out the record for an appeal.

Namchak Foundation filed an application for the mark COMPASSION IN ACTION in Class 45.^[1] Namchak's application originally covered "*Religious and spiritual services, namely, providing gatherings and retreats to develop and enhance the spiritual lives of individuals.*" However, Namchak narrowed its services further to "*Religious and spiritual services, namely, providing gatherings and retreats to develop and enhance the spiritual lives of individuals **interested in the teachings and practices of the Namchak Tibetan Buddhist Fellowship***" (amendment in **bold**), after the trademark office initially refused its application.

Despite Namchak's efforts to narrow its application, the trademark office once again refused the application based on an alleged likelihood of confusion with The Salvation Army's COMPASSION IN ACTION registration for "*Religious and charitable services namely providing meals for indigent people, residential care for homeless men, gifts for elderly shut-ins, gifts for patients in hospitals, rest homes and infirmaries, gifts for imprisoned persons, and gift packages to members of the armed forces*" in Class 42.^[2] After several rounds of arguments and subsequent refusals, Namchak appealed the trademark office's decision.

The crux of the case, and the primary reason the Board disagreed with the trademark office, is the Board's conclusion that there was no evidence suggesting Namchak's and The Salvation Army's services were related. The trademark office bears the burden of showing services are related. To meet this burden, the trademark office cited six websites allegedly showing other religious organizations providing both Namchak's and The Salvation Army's services. The Board, however, was not swayed by this evidence for two main reasons.

First, the trademark office did not accurately interpret the parties' services. Namchak deftly sidestepped potential unhelpful website evidence because it limited its description specifically to services for individuals interested in Namchak's Buddhist fellowship. The trademark office incorrectly focused on the beginning of Namchak's and The Salvation Army's services description, without taking into account the descriptions as a whole. At best, the evidence showed Christian organizations holding gatherings and providing charitable services. But it did not show Buddhist religious gatherings, let alone those related to the Namchak Tibetan Buddhist Fellowship, and definitely not Buddhist organizations that also provide meals for indigent people, housing for homeless men, gifts for the elderly, or any of the other services provided by The Salvation Army.

Second, the Board noted that pointing to only six websites is insufficient and does not meet the trademark office's burden of proof. In other words, the trademark office should have cited more evidence in the various refusals issued prior to Namchak's appeal. The Board acknowledged that a more developed record might have showed the parties' services were related.

The Board's decision demonstrates that a strategically narrow description of goods/services can be enough to overcome a likelihood of confusion refusal. Namchak was particularly successful here because its narrow identification not only eliminated overlap between the parties' services on their face, but also rendered the trademark office's evidence moot. Ultimately, The Salvation Army and Namchak are both free to continue practicing COMPASSION IN ACTION without confusion on the trademark register.

^[1] The Board's Final Decision, issued March 6, 2025 incorrectly indicated Namchak's services were in Class 30. However, the Board issued a Notice of Correction on March 12, 2025, correcting this clerical error.

[2] This was an ex parte proceeding. The Salvation Army did not oppose Namchak's application or otherwise participate in the application's examination or appeal.